



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/551,179 Confirmation No. :
First Named Inventor : Heinrich A. EBERL
Filed : September 29, 2005
TC/A.U. :
Examiner :

Docket No. : 101795.56308US
Customer No. : 23911

Title : Method and System for Providing Information on the
Eye

DECLARATION

Mail Stop Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, David P. Dickerson, with regard to United States patent application serial number
10/551,179 do hereby declare:

1. I am a citizen of the United States of America, residing at Wippenhauser Strasse
16, 85354 Freising, Germany. I make this declaration in support of the accompanying
Second Renewed petition to Revive the above-identified application.

2. While the delay between the deadline for entering the US national stage and
the filing of documents for entry into the US national stage was lengthy, I stand to my
previous statement that the delay was, in fact, unintentional. In the following, I explain, in
further detail, the circumstances that caused the delay.

3. Three events occurred in 2002 that were pivotal in setting the financial, professional and personal framework for the period of the delay at question. I thus consider it appropriate to begin my explanation of the delay with a discussion of these events as necessary background information. The implications thereof should be kept in mind when reading this document.

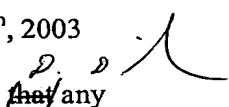
4. First, I was hospitalized on several occasions the spring and summer of 2002. It took several months until my illness was reliably diagnosed. The treatment of my illness and my rehabilitation therefrom has required a considerable investment in terms of time on a regular, for some time even daily, basis ever since.

5. Secondly, my only child was born in June of 2002, which imposed a substantial time requirement on my limited time resources.

6. Thirdly, my previous employer, Physoptics Opto-Electronics GmbH, unexpectedly entered bankruptcy in August 2002. Not only was I soon out of a job, I also lost considerable money as a result of Physoptics' bankruptcy. Thus, it was initially important that I personally do as much of the preparatory work as possible.

7. My battle to obtain control over my rightful share of Physoptics' IP portfolio began within days of Physoptics' bankruptcy. In May 2003, when it became apparent that legal prodding would be necessary to gain control over my rightful share, I filed a lawsuit against Physoptics as represented by the trustee. The battle culminated in the unexpected settlement of November 20th, 2003.

8. Between the termination of my employment with Physoptics in November 2002 and transfer of documents on November 20th, 2003 pursuant to the settlement, I did not have access to Physoptics files excepting those parts publicly accessible via the EPO's online file inspection services. At that time, such file inspection did not cover many documents relating to international preliminary examination under the PCT. As I recall, I did not begin piecing together the fifteen files I acquired via the settlement until after November 20th, 2003 since I had expected to receive the entire files from the trustee and had only limited office facilities of my own.

9. To the best of my recollection, I was not aware of the November 24th, 2003 deadline in the present case at that time. However, in all events, I then believed ~~that~~ any  undertaking of action to be futile.

10. The settlement with the trustee was concluded on Thursday, November 20th, 2003. The deadline for entering the national stage ended at midnight on Monday, November 24th, 2003. As I recall, Friday, November 21st, 2003 and Monday, November 24th, 2003 were workdays, during which I could not attend to this matter *pro se*.

11. Until the fall of 2006, I was of the erroneous, yet firm belief that the US national stage could not be entered on the basis of non-English application documents. Thus, had I been aware of the deadline, I would have believed it necessary to prepare English documents suitable for filing as a US application, which would have been extremely difficult or


impossible in the course of a single weekend, particularly in view of the fact that I, at that time, had no office facilities at my personal disposal.

12. Compounding the perceived problems of translation and clerical tasks were perceived problems of payment and filing. At that time, I was not aware of the possibility of payment by credit card. Yet I had previously encountered what I regarded to be a general rule that applications may not be filed with the USPTO by fax. Thus, had I been aware of the deadline, I would have believed it impossible for me to enter the US national stage without the aid of a US patent attorney/agent willing to advance the official fees for entry into the US national stage.

13. Clearly, even if I had been aware of the deadline, the aforementioned, seemingly insurmountable hurdles would have prevented me from timely fulfilling the deadline, without any intention to abandon the application. Indeed, given the vast efforts I had undertaken in the time between Physoptics' bankruptcy and November 2003 to obtain *de facto* control over at least my *de jure* rights to Physoptics' IP portfolio, it should be apparent that my intention to prosecute the entire portfolio before the two most frequently chosen patent offices, namely the USPTO and the EPO, did not change in the four days immediately after I had gained control of this application.

14. Prior to the spring of 2003, it was my belief that failure to timely enter the US national stage is a terminal deficiency lacking legal remedy. It was not until the spring of 2003 that I first heard a sketchy description of the remedies provided for in 37 CFR 1.137.

15. From the date I acquire the portfolio to the date entry into the US national stage was requested, I was of the belief that the technically/commercially significant applications in the portfolio I had acquired had a value of several million dollars. My belief was based on a professional valuation of Physoptics' portfolio that had been carried out in late 2001 that valued the portfolio at several tens of million dollars.


16. The beliefs set forth in items ~~7~~¹⁵ and ~~8~~¹⁵ *supra* best reflect the strong motivation behind my firm intention to attend to the missed deadline presently in question as promptly as possible under the circumstances.

17. As a consequence of Physoptics' bankruptcy, the deadline for entering the European regional stage for all of the PCT applications in Physoptics' portfolio was extended until early January of 2004. Accordingly, I had several weeks in which to carefully deliberate which of the eight PCT applications in Physoptics' portfolio I wished to prosecute before the EPO. Of the eight, I chose to prosecute six before the EPO. Given that the costs of European and US prosecution and that the market coverage provided by US and European patents are comparable, the decisions I made re prosecution before the EPO in early 2004 reflected my intention to prosecute these same six applications before the USPTO.

18. From late November to mid-December 2003, my foremost focus was to obtain financing for prosecution of the acquired portfolio. My financing plans covered the official fees in the US and Europe as well as the costs of representation in the US for the first few years of prosecution. For the sake of quality more than for the sake of saving costs, my financing plans assumed that I would represent myself before the EPO and that I would

prepare all necessary translations for US prosecution.

19. Until the fall of 2006, as stated above, I was of the belief that each of the six PCT applications I desired to prosecute needed to be translated into English to enter the US national stage. I myself had written all but one of those applications. In my experience, I have encountered numerous “professionally” translated applications that have lost a significant, if not decisive amount of their original disclosure during translation. For the sake of saving costs, but more predominantly for the sake of obtaining the best possible translation, it was my desire to translate the six applications myself.

20. Throughout 2004, I had only limited office facilities of my own. Most particularly, I had no office in which to work. I was thus forced to do all personal paperwork in the living room of my small apartment, which was also occupied by my wife and two year old son.

21. In January 2004, I was urgently busy gathering and documenting the necessary materials for my 2002 German tax return. This task had been overly delayed due to the failure/inability of the person who manages our apartment house to prepare a correct balance for 2002. In the end, my co-owners and I had to seek third party assistance.

22. In early 2004, I was further set back in that my weekends and evenings were also partially dedicated to studying for the so-called “European Qualifying Exam” (EQE) for admittance to the EPO bar that I took in March 2004. Since the EQE is only offered once a year, failure to appropriately study for and take the exam would have evoked reprimand from

my employer.

23. Throughout 2004, yet particularly in the first half of 2004, I was aggravatingly bogged down with paperwork in conjunction with a complex, multilateral legal battle over responsibility for hefty water damage to several rooms of my (and others') apartment(s) from the building's drain system.

24. In May 2004, I was sick for several weeks.

25. In April 2004, I unexpectedly inherited a small sum from a relative in the US. Since it was apparent that these funds could be useful for covering future USPTO fees as well as some of the costs of representation in the US, I decided it would be wise to open a US bank account, if not also for the sake of easing such payments. This endeavor lasted from early June 2004 to mid-August 2004 and generated considerable paperwork. In fact, I did not receive the necessary account documents such as check and deposit slips until late September 2004 and it was not until October 2004 that money was actually in the account.

26. In the latter half of 2004, as it became apparent that my ability to work at home was not commensurate with the rapidly growing amount of portfolio-related paperwork I had to tackle, I began searching for affordable office space near home as well as for the necessary office equipment and furnishings. I was able to conclude a lease in late November 2004 and spent an unpleasant proportion of my Christmas holidays ironing out the quirks inherent to modern office equipment.

27. On November 10th, 2004, in the midst of my search for office space/equipment, I first wrote to my present US patent attorney, Gary Edwards, briefly elucidating my situation and inquiring re representation. By this time, my financial situation was slowly, but surely improving to the point where I felt comfortable, at least from a financial point of view, engaging a third party translator for translating the PCT applications for US prosecution. I received a reply from my U.S. attorney on November 24, 2004 that requested more detailed information.

28. Having an office greatly increased my productivity. Nonetheless, a considerable backload had already grown. In addition to the "normal" paperwork that one has, prosecution of the six Euro-PCT applications was in full swing. In first three months of 2005, I was further set back in that my weekends and evenings were also partially dedicated to studying for a re-sit of the EQE.

29. On February 13th, 2005, I replied to my attorney's inquiry with a detailed, 13 page summary providing a basis for assessing whether representation could provoke a conflict of interest, elucidating the complex ownership problems and asking what we would need to enter the US national stage.

On February 26th, 2005, my attorney tentatively agreed to take over representation. His reply did not detail the minimum requirements for entering the US national stage or answer my question of February 13th, 2005.

30. Roughly one month after the EQE, on April 17, 2005, I provided my attorney

with what I believed to be the requisite materials and instructions for entering the US national stage as regards PCT/EP01/11634 (15). The documents for PCT/EP01/11633 (14) and PCT/EP02/04030 (16) as well as revised claims for PCT/EP01/11634 (15) followed on April 24, 2005. The documents for PCT/EP00/09843 (7) followed on April 25, 2005. Since it had been agreed that my attorney would arrange for translation, the majority of the aforementioned documents were in German. While it may appear that the documents were swiftly and easily prepared, such assessment is not correct. The near simultaneous mailing was a result of my pooling of like tasks for the sake of efficiency.

31. In June 2005, my son turned 3. Under German law, a woman who has taken maternity leave must return to work no later than the child's third birthday or forfeit her previous position. As I result, I was responsible for my son every Friday from June 2005 until his kindergarten began in September 2005.

32. In July and August 2005, my thoughts and energy were strongly focussed on my rapidly deteriorating employment situation. Mismanagement had created a critical backload of files bound by official and client deadlines.

33. In September 2005, I spent considerable time providing my US tax advisor with the requisite paperwork for preparing my overdue 2003 and 2004 US tax returns.

34. On October 3rd, 2005, I provided my attorney with the requisite documents for PCT/EP00/09840 (8) and PCT/EP00/09841 (9). Again, the majority of these documents were in German.

35. I believe that the above summary of the major events in my personal life between 2002 and my provision of the last of what I believed to be the requisite documents for entering the US national stage on October 3rd, 2005 sufficiently documents that the delay was not intentional, but was instead the result of ~~numerous occurrences that impacted~~ *the circumstances, including* my living situation, my health situation and a strict budget.

36. At no time has it ever been my intention to abandon this application. In fact, on the contrary, it was and has always been my steadfast determination to prosecute this application in the United States.

37. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such wilful false statements may jeopardize the validity of the present patent application or any patent issued thereon.

David Dickerson

Dated: Jan. 22nd, 2007